

Serial No.: 09/690,199
Accompanying Amendment

Docket No. 1005.7
Customer No. 000053953

REMARKS

Applicant respectfully requests reconsideration of this application in view of the following remarks. Claims 1, 8 and 15 have been amended. Claims 2-7, 9-14, and 16-24 have been cancelled. Claims 1, 8 and 15 are pending. No new matter has been entered.

Substitute Title

Applicant respectfully asks the Examiner to formally accept the substitute title.

Rejection of the claims

The most recent Office Action rejected claims 1, 8 and 15 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,486,895 ("Robertson").

As amended, claim 1 recites:

1. A method performed by a computer system, comprising:
storing an electronic version of a paper, wherein the electronic version is displayable on a display device as a likeness of a hardcopy version of the paper; and
in response to content of a first portion of the likeness, forming a hyperlink reference and embedding the hyperlink reference within the first portion of the likeness, wherein the hyperlink reference is associated with a second portion of the likeness, such that when the first portion of the likeness is displayed on the display device, the first portion of the likeness is selectable by a user to cause the computer system to display the second portion of the likeness on the display device, and wherein the content is at least one of the following: a page number at which the second portion of the likeness is located within the paper; and a title of the second portion of the likeness.

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As amended, claim 8 recites:

8. A system, comprising:
a computing device for:
storing an electronic version of a paper, wherein the electronic version is displayable on a display device as a likeness of a hardcopy version of the paper; and
in response to content of a first portion of the likeness, forming a hyperlink reference and embedding the hyperlink reference within the first portion of the likeness, wherein the hyperlink reference is associated with a second portion of the likeness, such that when the first portion of the likeness is displayed on the display device, the first portion of the likeness is selectable by a user to cause the computing device to display the second portion of the likeness on the display device, and wherein the content is at least one of the following: a page number at which the second portion of the likeness is located within the paper; and a title of the second portion of the likeness.

As amended, claim 15 recites:

15. A computer program product, comprising:
a computer program processable by a computer system for causing the computer system to:
store an electronic version of a paper, wherein the electronic version is displayable on a display device as a likeness of a hardcopy version of the paper; and
in response to content of a first portion of the likeness, form a hyperlink reference and embed the hyperlink reference within the first portion of the likeness, wherein the hyperlink reference is associated with a second portion of the likeness, such that when the first portion of the likeness is displayed on the display device, the first portion of the likeness is selectable by a user to cause the computer system to display the second portion of the likeness on the display device, and wherein the content is at least one of the following: a page number at which the second portion of the likeness is located within the paper; and a title of the second portion of the likeness; and
an apparatus from which the computer program is accessible by the computer system.

In MPEP § 2131, the PTO provides that:

"[t]o anticipate a claim, the reference must teach every element of the claim...."

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Therefore, to sustain a rejection of claim 1, Robertson must contain all of the above-recited elements in claim 1. However, Robertson fails to teach the combination of elements in amended claim 1.

For example, the September 20, 2005 Advisory Action cites Robertson's teaching of "Back," "Scan<" and "Scan>" buttons. However, such buttons fail to teach the element in claim 1 of "wherein the content is at least one of the following: a page number at which the second portion of the likeness is located within the paper; and a title of the second portion of the likeness." Accordingly, Robertson fails to teach the combination of elements in amended claim 1, and Robertson therefore fails to support a rejection of amended claim 1 under 35 U.S.C. § 102(e).

In relation to amended claims 8 and 15, Robertson is likewise defective in supporting a rejection under 35 U.S.C. § 102(e).

Moreover, as stated in MPEP § 2142, "...The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness..." Also, MPEP § 2142 states: "...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made...The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'" Further, MPEP § 2143.01 states: "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."

In relation to claim 1, Robertson is defective in establishing a prima facie case of obviousness. As between Robertson and Applicant's specification, only Applicant's specification teaches the combination of elements in amended claim 1. In fact, Robertson teaches away from such a combination. Accordingly, the PTO's burden of factually supporting a prima facie case of obviousness has not been met.

In relation to amended claims 8 and 15, Robertson is likewise defective in establishing a prima facie case of obviousness.

Thus, a rejection of amended claims 1, 8 and 15 is not supported.

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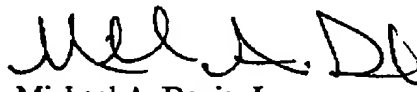
Conclusion

For these reasons, and for other reasons clearly apparent, Applicant respectfully requests allowance of claims 1, 8 and 15.

To the extent that this Accompanying Amendment results in additional fees, the Commissioner is authorized to charge deposit account no. 50-3524.


Applicant has made an earnest attempt to place this case in condition for allowance. If any unresolved aspect remains, the Examiner is invited to call Applicant's attorney at the telephone number listed below.

Respectfully submitted,



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